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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/547,686	06/30/2006	Mark Shuster	25791.241.05	7034
62519 7590 04/10/2008 HAYNES AND BOONE, LLP 901 MAIN STREET SUITE 3100 DALLAS, TX 75202-3789				
EXAMINER				
BOMAR, THOMAS S				
ART UNIT		PAPER NUMBER		
3676				
MAIL DATE		DELIVERY MODE		
04/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/547,686

**Applicant(s)**

SHUSTER ET AL.

**Examiner**

Shane Bomar

**Art Unit**

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because it merely repeats the title. Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities: paragraphs 002 and 0037 contain blanks of missing information that must be filled in by the Applicant.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7-22 and 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,688,397 of McClurkin et al.

Regarding claims 7-18, McClurkin et al disclose apparatuses, methods, and systems that comprise:

a support member 57, and an adaptive expansion device 35 coupled to the support member for radially expanding and plastically deforming the tubular member 22, comprising: a support structure 44 coupled to the support member; and one or more expansion device segments 36 coupled to the support structure for engaging the tubular member to thereby radially expand and plastically deform the tubular member; one or more sensors 118 for sensing one or more

operating conditions during the radial expansion and plastic deformation of the tubular member; and a controller operably coupled to the expansion device segments and the sensors; and wherein the controller is programmed to controllably adjust one or more of the operational characteristics of one or more the expansion device segments as a function of the operating conditions sensed by the sensors (Figs. 1, 3, 4, and 12; col. 3, lines 36-67; col. 6, lines 41-58).

Furthermore, the tubular member 12 can be made up of a string of liner segments that are coupled to one another via threaded connections, as is notoriously known in the wellbore art. As the sensors are said to detect the inside diameter of the tubular, then the overlap at the threaded connection will inherently be sensed. Also, the sensors are operationally connected to each of the expansion device segments 36 and thus control the adjustable measurements taken from the segments. Lastly, the controller is said to detect the wellbore profile and risk areas, thus the subterranean formation is sensed by the controller (col. 6, lines 41-58).

Regarding claims 19-22 and 27-29, there are one or more expansion surfaces since there are multiple segments 36; 50 is an actuator with a plurality of degrees of freedom in the springs 52 (Figs. 3-5).

Regarding claim 24, the device is moved in the longitudinal direction in the tubular (Fig. 1).

Regarding claim 25, one of the expansion devices is rotated relative to the other and thus relative to the tubular (col. 3, lines 8-20).

Regarding claim 26, pressurized fluid is applied to the interior surface as any fluid that is caught between the expanding element and the interior of the tubular will be pressurized to a certain degree.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClurkin et al in view of the Applicant's own disclosure.

McClurkin et al teach apparatuses, methods, and systems in claims 7-18 that contain all of the claimed limitations in claims 1-6, with the exception of damping elements so that a damping rate and frequency can be sensed and controlled by the controller. However, the Applicant admits in paragraph 0028 that such adjustable damping elements are already disclosed in the prior art, thus at the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the adjustable damping elements and frequency control of the prior art with the expansion device of McClurkin et al to achieve the predictable result of damping the movement of the device during expansion.

***Conclusion***

8. The prior art made of record on form 892 and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is (571)272-7026. The examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer H. Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shane Bomar/  
Examiner, Art Unit 3676